

REMARKS

1. In response to the Final Office Action mailed September 12, 2007, Applicants respectfully request reconsideration. Claims 20-37 and 73 were last presented for examination while claims 38-72 and 74-76 were withdrawn from consideration. In the outstanding Office Action claims 20-37 and 73 are rejected. By the foregoing Amendments, claims 20, 21, 27-31, 34, 36 and 73 have been amended and claims 23 and 24 have been cancelled. No claims have been added. Thus, upon entry of this paper, claims 20-22, 25-37 and 73 will remain pending in this application. Of these fifty-seven (57) claims, four (4) claims (claims 20, 38, 56 and 73) are independent.

2. Based upon the above Amendment and following Remarks, Applicants respectfully request that all outstanding objections and rejections, be reconsidered, and that they be withdrawn.

Art of Record

3. Applicants acknowledge receipt of form PTO-892 listing additional reference identified by the Examiner.

Dependent Claims 74-76

4. In the previous restriction requirement the Examiner asserted that claim 73 was a generic claim and that claims 74-76 were directed to different species. In view of the following arguments, Applicants assert that generic claim 73 is allowable over the art of record. As such, Applicants respectfully request that the Examiner rejoin claims 74-76.

Claim Rejections under 35 U.S.C § 102(b) in view of Cichon

5. Claims 20, 21, 23, 24, 35, 37 and 73 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 1,657,497 to Cichon, (hereinafter, "Cichon"). Applicants respectfully disagree.

6. Cichon discloses tweezers "adapted to be used by a jeweler in the repairing of watches and the like." (See, Cichon, lines 3-4.) The "inner faces of the fingers 8 are provided with notches 11 and 12, the notches 11 being able to register with each other as are also the notches 12."

(See, Cichon, lines 45-48.) The Examiner has equated the “notches” of Cichon to the concave region claimed by Applicants.

7. As can be clearly seen in Figure 5 of Cichon, the “notches” are perpendicular to the longitudinal axis of the tweezer faces. Due to this perpendicular position of the notches, Applicant asserts that Cichon fails to teach or suggest a device as claimed in Applicants’ amended claim 20. Specifically, the tweezers of Cichon having perpendicular notches completely fail to teach a “a first flexible arm comprising contiguous first and second elongate regions... a length of said second region comprising a concave cross-sectional shaped region...and a second flexible arm... having a tip region; *wherein a longitudinal axis through said concave-shaped cross-sectional region is substantially parallel to a longitudinal axis of said tip region*” as recited, in part, in Applicants’ claim 20. (Emphasis added.)

8. Therefore, for at least this reason, Applicants assert that amended claim 20 is patentable over Cichon. Applicants respectfully request that the rejection of claim 20 as anticipated by Cichon be reconsidered, and that it be withdrawn.

9. For at least the same reasons as discussed above with reference to claim 20, Applicants assert that Cichon fails to teach or suggest all elements of Applicants’ claim 73. As discussed above, the notches of Cichon are perpendicular to the longitudinal axis of the tweezer arms. (See, Cichon, FIG. 5.) As such, Applicants assert that the “notches” of Cichon fail to teach or suggest “a first elongate arm having a longitudinal axis... and a structure proximate said distal end that forms at least a portion of a surface of a concave-shaped cross-sectional region having a longitudinal axis substantially aligned with said longitudinal axis of said first elongate arm” as recited, in part, in claim 73. Therefore, for at least these reasons, Applicants assert that amended claim 73 is patentable over Cichon. Applicants respectfully request that the rejection of claim 73 as anticipated by Cichon be reconsidered, and that it be withdrawn.

Claim Rejections under 35 U.S.C § 102(b) in view of Bloomberg

10. Claims 20-24, 27, 35, 37 and 73 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,738,366 to Blomberg, (hereinafter, “Blomberg”). Applicants respectfully disagree.

11. Bloomberg is directed to a disposable forceps comprising two identical members that may be closed together to perform a “variety of functions” such as removing sutures, handling dressings and cotton balls, manipulating cut or damaged skin, etc. (*See*, Bloomberg, col. 1, lines 7-15.) The forceps of Bloomberg are manufactured from a light gauge material that is inexpensive, thereby making it economical to dispose the forceps after use. (*See*, Bloomberg, col. 1, lines 7-15.) Bloomberg further indicates that the forceps only require the use of light gauge material because “[t]he body of the forceps is formed with a U-shaped configuration to provide the necessary rigidity.” (*See*, Bloomberg, col. 1, lines 7-15.) In Bloomberg, both members that close together have the U-shaped configuration. (*See*, Bloomberg, col. 2, lines 59-68.) As can clearly be seen in Figures 1, 5 and 8 of Bloomberg, the open part of the U-shape of each member **faces away from the other member**. As explained in the description of claim 5, “the tip 20 of top member 2 includes a bent down end have a surface 22 which bears in pressure contact with a similar surface at the tip of member 3. The respective surfaces are utilized to manipulate... material[s].” (*See*, Bloomberg, col. 4, lines 9-14.) The fact that these material manipulating surfaces extend from the edge of the bottom of U-shape support the premise that the open portion of the U-shaped members face away from one another.

12. Due to the fact that the open portions of the U-shaped members face away from one another, Applicants assert that Bloomberg fails to teach all elements of Applicants’ claim 20. Specifically, Applicants assert that Bloomberg fails to teach or suggest “a first flexible arm comprising contiguous first and second elongate regions... a length of said second region comprising a concave cross-sectional shaped region... and a second flexible arm .. having a tip region ... wherein application of a force to at least one of said first regions causes said tip region to travel toward said concave cross-sectional shaped region, and when said tip is in proximity to said concave cross-sectional shaped region said electrode assembly is retained in a space defined by said concave cross-sectional shaped region” as recited, in part, in amended claim 20. Bloomberg completely fails to teach the above elements because it would be physically impossible for the outward facing U-shapes of Bloomberg to retain an electrode assembly in either of the U-shaped arms. As would be obvious to one of ordinary skill in the art, the forceps of Bloomberg disclose no structure that would permit such retention in the U-shapes.

13. Therefore, for at least these reasons, Applicants assert that amended claim 20 is patentable over Bloomberg. Applicants respectfully request that the rejection of claim 20 as anticipated by Bloomberg be reconsidered, and that it be withdrawn.

14. For at least the same reasons as discussed above with reference to claim 20, Applicants assert that Bloomberg fails to teach or suggest all elements of Applicants' claim 73. As discussed above, the open portion of the U-shaped forceps members face outward. (*See*, Bloomberg, col. 4, lines 9-14) As such, Applicants assert that the U-shaped members of Bloomberg fail to teach or suggest "a first elongate arm having... concave-shaped cross-sectional region... wherein said concave-shaped cross-sectional region enables said first elongate arm to receive and support the electrode assembly... and a second elongate arm having... a tip region... to retain the electrode assembly in a space between said concave-shaped cross-sectional region and said tip region" as recited, in part, in claim 73. Therefore, for at least these reasons, Applicants assert that amended claim 73 is patentable over Bloomberg. Applicants respectfully request that the rejection of claim 73 as anticipated by Bloomberg be reconsidered, and that it be withdrawn.

Claim Rejections under 35 U.S.C § 102(b) in view of Baschenis

15. Claims 20, 21, 32, 33, 37 and 73 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,352,293 to Baschenis, (hereinafter, "Baschenis"). Applicants respectfully disagree.

16. In the above amendments, Applicants have amended claim 20 to include the limitations of former claims 23 and 24. Specifically, claim 20 now recites, in part, a "second region comprising a concave cross-sectional shaped region, wherein said concave cross-sectional shape enables said second region to receive and support said electrode assembly *such that relative longitudinal movement of said electrode assembly is permitted while relative lateral movement of said electrode assembly is substantially restricted.*" (Emphasis added.) In the Final Office Action, the Examiner implicitly recognized that Baschenis fails to teach these features because the Examiner did not reject former claims 23 and 24 as unpatentable over Baschenis. For at least this reason, Applicants assert that amended claim 20 is patentable over Baschenis.

17. Applicants further assert that amended claim 20 is patentable over Baschenis for the additional reason that Baschenis fails to teach or suggest “a first flexible arm...comprising a concave cross-sectional shaped region... a second flexible arm... having a tip region; wherein a longitudinal axis through said concave-shaped cross-sectional region is substantially parallel to a longitudinal axis of said tip region” as recited, in part, in claim 20. Baschenis is merely directed to a pair of tweezers that have opposing “specifically shaped gripping cups formed at one end for securely holding a bead, pearl, or the like.” (*See*, Baschenis, col. 1, lines 58-62.) The Examiner has completely failed to show a device having a cupped end region is equivalent to a device as recited above.

18. Therefore, for at least this additional reason, Applicants assert that amended claim 20 is patentable over Baschenis. Applicants respectfully request that the rejection of claim 20 as anticipated by Baschenis be reconsidered, and that it be withdrawn.

19. For at least the same reasons as discussed above with reference to claim 20, Applicants assert that Baschenis fails to teach or suggest all elements of Applicants’ claim 73. As discussed above, the Examiner has implicitly recognized in the Final Office Action that Baschenis fails to teach the elements of former claims 23 and 24. Applicants’ claim 73 includes similar elements to those that appear to be lacking in Baschenis, including a “concave-shaped cross-sectional region [that] enables said first elongate arm to receive and support the electrode assembly such that relative longitudinal movement of the electrode assembly is permitted while relative lateral movement of the electrode assembly is substantially restricted.” (*See*, Applicant’s claim 73.)

20. Furthermore, Applicants assert that claim 73 is further patentable over Baschenis because, for the reasons discussed above with reference to claim 20, Baschenis fails to teach “a concave-shaped cross-sectional region having a longitudinal axis substantially aligned with said longitudinal axis of said first elongate arm, wherein concave-shaped cross-sectional region enables said first elongate arm to receive and support the electrode assembly” as recited, in part, in claim 73. Therefore, for at least these reasons, Applicants assert that amended claim 73 is patentable over Baschenis. Applicants respectfully request that the rejection of claim 73 as anticipated by Baschenis be reconsidered, and that it be withdrawn.

Claim Rejections under 35 U.S.C § 102(b) in view of Baccala

21. Claims 20-24, 27, 32, 37 and 73 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,785,810 to Baccala *et al.*, (hereinafter, “Baccala”). Applicants respectfully disagree.

22. Baccala is directed to a forceps like surgical instrument “used in replacement of the natural lenses in eyes with artificial lenses.” (*See*, Baccala, col. 1, lines 6-8.) Specifically, the surgical instrument of Baccala is used to fold an artificial lens, and then to insert the folded lens into an eye of a patient. (*See*, Baccala, col. 2, lines 39-65.) The instrument of Baccala comprises two connected jaws that perform this function. (*See*, Baccala, col. 3, lines 23-47.) One jaw of Baccala is a generally “circular hollowed out portion,” while the other jaw is an engaging portion in the form of a rod. (*See*, Baccala, col. 3, lines 23-47.) In operation, an artificial lens is placed on top of the hollowed out portion, and the engaging rod closes down on top of the lens. (*See*, Baccala, col. 6, lines 3-24.) The engaging rod continues into the hollowed out portion to force the lens into a U-shaped configuration. (*See*, Baccala, col. 6, lines 3-24; FIG. 5.) The two jaws are then locked together in the closed configuration until the lens is inserted into the eye. (*See*, Baccala, col. 6, lines 3-24.) Once the lens is in a proper position, the jaws are unlocked and the instrument is removed from the eye of the patient. (*See*, Baccala, col. 6, lines 3-24.)

23. Applicants assert that such a device as disclosed in Baccala fails to teach all elements of Applicants’ amended claim 20. Specifically, the device of Baccala fails to teach a “manually adjustable forceps tool for controlling an implantable electrode assembly of a stimulating medical device comprising: a first flexible arm... comprising a concave cross-sectional shaped region, wherein said *concave cross-sectional shape enables said second region to receive and support said electrode assembly such that relative longitudinal movement of said electrode assembly is permitted while relative lateral movement of said electrode assembly is substantially restricted*” as recited, in part, in claim 20. (Emphasis added.) Baccala completely fails to teach a tool capable of receiving and supporting an electrode assembly. As described above, the tool of Baccala is merely directed to a jaw arrange that is configured to fold a lens, and then retain the lens therein. (*See*, Baccala, col. 6, lines 3-24.) Baccala lacks any teaching to suggest that the tool of Baccala may be used for any other purpose, let alone to receive and

support an electrode assembly. Baccala further fails to teach the above elements because the tool of Baccala, even if capable of receiving and supporting an electrode assembly, is totally incapable of retaining the electrode assembly in a manner “such that relative longitudinal movement of said electrode assembly is permitted while relative lateral movement of said electrode assembly is substantially restricted” as recited, in part, in claim 20. Without any teaching or suggestion, Applicants assert that it would be unreasonable to find that Baccala teaches the above elements.

24. Applicants further assert that the device of Baccala fails to teach a “manually adjustable forceps tool for controlling an implantable electrode assembly of a stimulating medical device comprising: a first flexible arm... comprising a concave cross-sectional shaped region... a second flexible arm... having a tip region; wherein... when said tip is in proximity to said concave cross-sectional shaped region said electrode assembly is retained in a space defined by said concave cross-sectional shaped region and said tip region, *thereby providing operator control of the longitudinal movement of said electrode assembly*” as recited, in part, in claim 20. (Emphasis added.) As described above, the jaws of Baccala are merely configured to fold the lens into a U-shape, and then to firmly retain the folded lens between the jaws. (See, Baccala, col. 6, lines 3-24.) Baccala completely fails to disclose any type of control of the lens that would lead one of ordinary skill in the art to conclude that Baccala teaches the above recited elements.

25. Therefore, for at least these reasons, Applicants assert that amended claim 20 is patentable over Baccala. Applicants respectfully request that the rejection of claim 20 as anticipated by Baccala be reconsidered, and that it be withdrawn.

26. For at least the same reasons as discussed above with reference to claim 20, Applicants assert that Baccala fails to teach or suggest all elements of Applicants’ claim 73. As described above, the jaws of Baccala are merely configured to fold the lens into a U-shape, and then to firmly retain the folded lens between the jaws. (See, Baccala, col. 6, lines 3-24.) As such, Applicants assert that the jaws of Baccala fail to teach or suggest “a first elongate arm having... concave-shaped cross-sectional region... wherein said concave-shaped cross-sectional region enables said first elongate arm to receive and support the electrode assembly... and a second

elongate arm having... a tip region ... to retain the electrode assembly in a space between said concave-shaped cross-sectional region and said tip region, thereby providing operator control of the longitudinal movement of the electrode assembly” as recited, in part, in claim 73. Therefore, for at least these reasons, Applicants assert that amended claim 73 is patentable over Baccala. Applicants respectfully request that the rejection of claim 73 as anticipated by Baccala be reconsidered, and that it be withdrawn.

Claim Rejections under 35 U.S.C § 102(b) in view of Ruggles

27. Claims 20, 21, 23-25, 35-37 and 73 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 1,033,942 to Ruggles, (hereinafter, “Ruggles”). Applicants respectfully disagree.

28. Ruggles is directed to a tool to be used to “hold and manipulate work such as artificial teeth, crowns, bridge-work” or other objects used in dentistry. (*See*, Ruggles, lines 15-19.) The tool of Ruggles comprises “two jaws each consisting of a concave or spoon-shaped part, the edge of which terminates in a number of prongs.” (*See*, Ruggles, lines 42-46.)

29. Applicants assert that the device of Ruggles fails to teach several elements of Applicants’ claim 20. First, Ruggles fails to teach a “a first flexible arm...comprising a concave cross-sectional shaped region, ***wherein said concave cross-sectional shape enables said second region to receive and support said electrode assembly***” as recited in claim 20. As noted above, Ruggles merely discloses a pair of jaws, wherein each jaw is a spoon-shape. (*See*, Ruggles, lines 42-46.) Applicants assert that such a device as described in Ruggles cannot function to “receive and support” an electrode assembly.

30. Second, Ruggles fails to teach “wherein... when said tip is in proximity to said concave cross-sectional shaped region said electrode assembly is retained in a space defined by said concave cross-sectional shaped region and said tip region, ***thereby providing operator control of the longitudinal movement of said electrode assembly***.” (Emphasis added.) As noted, the tool of Ruggles is merely designed to grasp an object and retain such therein between the spoon-shaped jaws. Not only does Ruggles completely fail to teach the ability to retain an electrode assembly, but Ruggles further fails to teach any ability whatsoever to control the movement of a retained object, let alone the movement of an electrode assembly.

31. Therefore, for at least these reasons, Applicants assert that amended claim 20 is patentable over Ruggles. Applicants respectfully request that the rejection of claim 20 as anticipated by Ruggles be reconsidered, and that it be withdrawn.

32. For at least the same reasons as discussed above with reference to claim 20, Applicants assert that Ruggles fails to teach or suggest all elements of Applicants' claim 73. As described above, the tool of Ruggles merely comprises two spoon-shaped jaws, each terminating in a number of prongs. (*See*, Ruggles, lines 42-46.) As such, Applicants assert that the jaws of Ruggles fail to teach or suggest "a first elongate arm having... concave-shaped cross-sectional region... wherein said concave-shaped cross-sectional region enables said first elongate arm to receive and support the electrode assembly... and a second elongate arm having... a tip region ... to retain the electrode assembly in a space between said concave-shaped cross-sectional region and said tip region, thereby providing operator control of the longitudinal movement of the electrode assembly" as recited, in part, in claim 73. Therefore, for at least these reasons, Applicants assert that amended claim 73 is patentable over Ruggles. Applicants respectfully request that the rejection of claim 73 as anticipated by Ruggles be reconsidered, and that it be withdrawn.

Claim Rejections under 35 U.S.C § 102(b) in view of Weinrib

33. Claims 20, 29, 32, 34, 37 and 73 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,793,349 to Weinrib, (hereinafter, "Weinrib"). Applicants respectfully disagree.

34. In the above amendments, Applicants have amended claim 20 to include the limitations of former claims 23 and 24. Specifically, claim 20 now recites, in part, a "second region comprising a concave cross-sectional shaped region, wherein said concave cross-sectional shape enables said second region to receive and support said electrode assembly ***such that relative longitudinal movement of said electrode assembly is permitted while relative lateral movement of said electrode assembly is substantially restricted.***" (Emphasis added.) In the Final Office Action, the Examiner implicitly recognized that Weinrib fails to teach these features because the Examiner did not reject former claims 23 and 24 as unpatentable over Weinrib. For at least this reason, Applicants assert that amended claim 20 is patentable over Weinrib.

35. Applicants further assert that amended claim 20 is patentable over Weinrib for the additional reason that Weinrib fails to teach or suggest “a first flexible arm...comprising a concave cross-sectional shaped region... a second flexible arm... having a tip region; wherein a longitudinal axis through said concave-shaped cross-sectional region is substantially parallel to a longitudinal axis of said tip region” as recited, in part, in claim 20. Weinrib is merely directed to a tweezer-like needle holder having one jaw with a hook-shape, and a second jaw with a substantially flat surface that cooperates with the hook to retain a needle therein. (*See*, Weinrib, col. 2, line 45- col. 3, line 9.) In Weinrib, the hook is used to lift a curved needle, and the second jaw pins the needle between the hook and the second jaw. (*See*, Weinrib, col. 3, lines 1-9.) As can be clearly be seen in Figures 5 and 5A of Weinrib, the surfaces of both jaws, including the face of the hook, are substantially flat.

36. Applicants assert that it is clear error for the Examiner to assert that the device of Weinrib described above teaches all elements of Applicants’ claim 20. Not only does Weinrib completely fail to teach the “concave-cross sectional shape” as described above, but Weinrib also fails to disclose how a needle holder, with a hooked shape jaw, would capable of receiving and retaining an electrode assembly, let alone retaining the electrode assembly in a “concave cross-sectional shaped region.”

37. Therefore, for at least these additional reasons, Applicants assert that amended claim 20 is patentable over Weinrib. Applicants respectfully request that the rejection of claim 20 as anticipated by Weinrib be reconsidered, and that it be withdrawn.

38. For at least the same reasons as discussed above with reference to claim 20, Applicants assert that Weinrib fails to teach or suggest all elements of Applicants’ claim 73. As discussed above, the Examiner has implicitly recognized in the Final Office Action that Weinrib fails to teach the elements of former claims 23 and 24. Applicants’ claim 73 includes similar elements to those that appear to be lacking in Weinrib, including a “concave-shaped region [that] enables said first elongate arm to receive and support the electrode assembly such that relative longitudinal movement of the electrode assembly is permitted while relative lateral movement of the electrode assembly is substantially restricted.” (*See*, Applicant’s claim 73.)

39. Furthermore, Applicants assert that claim 73 is further patentable over Weinrib because, for the reasons discussed above with reference to claim 20, Weinrib fails to teach “a concave-shaped cross-sectional region having a longitudinal axis substantially aligned with said longitudinal axis of said first elongate arm, wherein concave-shaped cross-sectional region enables said first elongate arm to receive and support the electrode assembly” as recited, in part, in claim 73. Therefore, for at least these reasons, Applicants assert that amended claim 73 is patentable over Weinrib. Applicants respectfully request that the rejection of claim 73 as anticipated by Weinrib be reconsidered, and that it be withdrawn.

Additional Prior Art

40. Applicants further assert that additional prior art cited by the Examiner, taken alone or in combination, fails to teach or suggest that which is missing from the above described references. As such, Applicants assert that claims 20 and 73 are patentable over the art of record.

Claim Rejections under 35 USC § 103

41. Claims 25 and 26 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Cichon in view of U.S. Patent No. 4,873,979 to Hanna (hereinafter, “Hanna”). Claim 28 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Ruggles in view of U.S. Patent No. 2,642,871 to Theurig (hereinafter, “Thuerig”). In addition, claim 31 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Weinrib in view of U.S. Patent No. 1,704,992 to Sanders (hereinafter, “Sanders”). Finally, claims 30 and 31 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Weinrib in view of U.S. Patent No. 791,322 to Clayton (hereinafter, “Clayton”). Applicants assert that these claims are patentable over the cited references. In particular, Applicants assert that the rejections under §35 U.S.C 103 are improper because, for the reasons discussed above in reference to claims 20 and 73, the cited references fail to teach or suggest that which the Examiner asserts. As such, Applicants respectfully request that the rejections of these claims under 35 U.S.C. §103(a) be reconsidered, and that they be withdrawn.

Dependent Claims

42. The dependent claims incorporate all of the subject matter of their respective independent claims and add additional subject matter, which makes them *a fortiori* independently patentable over the art of record. Accordingly, Applicants respectfully request that the outstanding rejections of the dependent claims be reconsidered and withdrawn.

Conclusion

43. In view of the foregoing, this application should be in condition for allowance. A notice to this effect is respectfully requested.

44. Applicants reserve the right to pursue any cancelled claims or other subject matter disclosed in this application in a continuation or divisional application, cancellations and amendments of above claims, therefore, are not to be construed as an admission regarding the patentability of any claims and Applicants reserve the right to pursue such claims in a continuation or divisional application.

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